

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

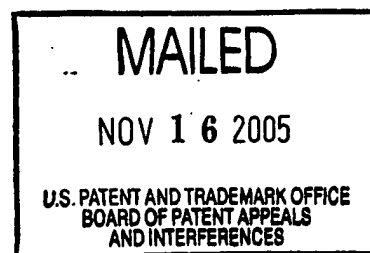
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HAROLD V. PUTMAN and DALE KLINGSHIRN

Appeal No. 2005-2622
Application No. 09/923,089

ON BRIEF



Before HAIRSTON, BARRY, and NAPPI, and, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-40. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm-in-part.

I. BACKGROUND

The invention at issue on appeal concerns automated teller machines ("ATMs"). Customers use ATMs to check the balance of accounts, deposit or withdraw cash, transfer funds between accounts, and pay bills. (Spec. at 1.)

The appellants' ATM (40) comprises two user stations (52, 54) connected to a computer (42). Each user station includes at least one display device (44, 46) and at

least one input device (48, 50). The first user station is in the front of the ATM; the second user station is in the back of the ATM. The first user station displays a user interface (92) for banking or a user interface for servicing the ATM. The second user station displays a user interface (94) for servicing the ATM. (Appeal Br. at 3.)

Responsive to a markup language document (100), a software application (106) generates elements (116, 120) for the user interfaces. Because the input devices (110, 111, 114) of the user stations may differ, the ATM determines the type of input device associated with each user station. (*Id.* at 3-4.) For example, the first user station may feature function keys (110, 111), while the second user station may feature a mouse (114). Responsive to the determination of the type of input device and to the markup language document, the software application outputs user interfaces that include elements for the types of input devices associated with each user station. For example, labels (116, 118) that indicate the functions associated with adjacent function key input devices (110, 111) are output for the first user interface, while a scroll bar (120) and buttons (122) that can be manipulated and selected via the mouse (114) are output for the second user interface. (*Id.* at 4.)

A further understanding of the invention can be achieved by reading the following claims.

1. An automated banking machine apparatus comprising:

at least one computer;

a plurality of transaction function devices in operative connection with the at least one computer;

a first display device and a second display device in operative connection with the at least one computer;

a first input device of a first type associated with the first display device and a second input device of a second type and different from the first type associated with the second display device, each of the first and second input devices in operative connection with the at least one computer; and

at least one software application operative in the at least one computer, wherein the at least one software application is operative to determine the first and the second types of the first and the second input devices, wherein the at least one software application is operative to cause a first user interface to be output through the first display device responsive to the determined first type of the first input device, and wherein the at least one software application is operative to cause a second user interface different from the first user interface to be output through the second display device responsive to the determined second type of the second input device.

2. The apparatus according to claim 1, wherein the at least one computer is operative to cause a desktop environment to be generated, wherein the desktop environment spans the first and second display devices.

29. The apparatus according to claim 1, wherein the automated banking machine includes a first user station and a second user station, wherein the first display device and the first input device are accessible by a user positioned adjacent the first user station, wherein the second display

device and the second input device are accessible by a user positioned adjacent the second user station, wherein both the first user interface and the second user interface are adapted to enable an authorized user to perform servicing operations with the machine while positioned adjacent either the first user station or the second user station of the machine.

8. An automated banking machine apparatus comprising:

a computer;

at least two user stations in operative connection with the computer, wherein each user station includes at least one display device and at least one input device; and

at least one software application operative in the computer, wherein the software application is operative to determine at least one capability of at least one input device included in each user station, and wherein the at least one software application is operative to cause a user interface to be output through the display device included in each user station, wherein the user interface for a user station is output responsive to the at least one capability associated with the at least one input device included in the user station.

24. A method comprising:

a) providing at least one first document and at least one second document to an automated banking machine;

b) determining at least one first type associated with a first input device on the machine, wherein the first input device is associated with at least one first display device on the machine;

c) presenting at least one first user interface through the first display device, responsive to the determined at least one first type, the at least one first document, and the at least one second document, wherein the at least one second document includes at least one language translation of indicia included in the first document.

Claims 1, 8, 9, 29, and 30 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,378,770 ("Clark"). Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as obvious over Clark. Claims 4-7, 10-28, and 31-40 stand rejected under § 103(a) as obvious over Clark and U.S. Patent No. 6,311,165 ("Coutts").

II. OPINION

Our opinion addresses the rejections in the following order:

- anticipation rejection of claims 1, 8, and 9 and obviousness rejection of claims 18, 19, 26, and 27
- anticipation rejection of claims 29 and 30 and obviousness rejection of claims 14, 20-23, 31-36, and 39
- obviousness rejection of claims 2 and 3
- obviousness rejection of claims 4-7, 10, and 11
- obviousness rejection of claims 12 and 13
- obviousness rejection of claims 15-17
- obviousness rejection of claims 24 and 25
- obviousness rejection of claim 28 and 40
- obviousness rejection of claim 37
- obviousness rejection of claim 38.

A. ANTICIPATION REJECTION OF CLAIMS 1, 8, AND 9
AND OBVIOUSNESS REJECTION OF CLAIMS 18, 19, 26, AND 27

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7) (2001)). "Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." 37 C.F.R. § 1.192(c)(7) (2000). "If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *McDaniel*, 293 F.3d at 1383, 63 USPQ2d at 1465.

Here, although the appellants allege, "No groups of claims stand or fall together," (Appeal Br. at 5), they fail to satisfy the second requirement for some claims. More specifically, their recitation of the limitations of claims 9, 19, and 27 and allegation that "nothing in the applied art discloses or suggests these features," (Appeal Br. at

11), or the like, (*id.* at 11, 27), does not constitute an argument that the claims are separately patentable. It does not challenge the rejection of the individual claims "with any reasonable specificity. . . ." *In re Nielsen*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Therefore, claim 9 stands or falls with representative claims 8, and claims 19 and 27 stand or fall with representative claim 18.

"With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we address the point of contention therebetween." *Ex parte Gaechter*, 65 USPQ2d 1690, 1692 (Bd.Pat.App & Int. 2002). The examiner finds that Clark's "control unit will display proper information on the display device after determining source of the input devices that is used by user or operator." (Examiner's Answer at 8.) The appellants argue, "nowhere does the Answer point to any teaching or suggestion that the controller unit (30) of Clark determines the types of these input devices." (Reply Br. at 4.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the claim at issue to determine its scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

1. Claim Construction

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). "[T]he Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 1 recites in pertinent part the following limitations:

at least one software application is operative to determine the first and the second types of the first and the second input devices, wherein the at least one software application is operative to cause a first user interface to be output through the first display device responsive to the determined first type of the first input device, and wherein the at least one software application is operative to cause a second user interface different from the first user interface to be output through the second display device responsive to the determined second type of the second input device.

Claims 18 and 26 recite in pertinent part similar limitations. For its part, claim 8 recites in pertinent part the following limitations:

at least one software application operative in the computer, wherein the software application is operative to determine at least one capability of at least one input device included in each user station, and wherein the at least one software application is operative to cause a user interface to be output through the display device included in each user station, wherein the user interface for a user station is output responsive to the at least one capability associated with the at least one input device included in the user station.

Giving claims 1, 8, 18, and 26 the broadest, reasonable construction, the limitations require determining either whether an input device is of a first or second type or a capability of the input device and then responsively displaying a corresponding user interface.

2. Anticipation and Obviousness Determinations

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002).

"[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)). Similarly, the question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)).

"A claim is anticipated . . . if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). Of course, "this is not an 'ipsissimis verbis' test." *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479 & n.11, 1 USPQ2d 1241, 1245 & n.11 (Fed. Cir. 1986)).

Here, Clark discloses an "ATM 10 . . . provided with a user panel 12 including a card reader slot 14 for insertion of a user's identification card, a key pad 16, a cash dispenser slot 18 through which bank notes are delivered to a user, a display screen 20 and a receipt printer slot 22. . . ." Col. 2, ll. 53-58. "The ATM 10 further comprises a controller unit 30 which communicates with components of the user panel 12, [and] with an operator panel 26 mounted inside the ATM. . . ." Col. 3, ll. 8-10. "The operator panel 26 includes a key pad 27, [and] a display screen 28. . . ." *Id.* at ll. 11-12.

"The controller unit 30 includes a processor unit 32, and a memory unit 34 connected . . . to the processor unit 32. The processor unit 32 receives input signals from the card reader 14, the user panel key pad 16 and the operator panel key pad 27, and provides output signals . . . to the displays 20 and 28 of the user and operator

panels 12 and 26. . . ." *Id.* at ll. 15-19. "It should be understood that the processor unit 32 controls . . . the information displayed on the displays 20 and 28. . . ." *Id.* at ll. 21-24. The processor unit 32 outputs different user interfaces to the user's display 20 and the operator's display 28. Items output to the user's display 20 include "[i]nstructions," col. 2, l. 65, a "request[] to enter a personal identification number (PIN)," *id.* at 66-67, "a menu of the various facilities available to the user," col. 3, ll. 3-4, and a "request[] to enter the sum required. . . ." *Id.* at ll. 5-6. Items output to the operator's display 28 include "a menu of the various maintenance procedure options, including a REPLENISH option," col. 5, ll. 61-63 and a "request[] to input data concerning the full cassettes 40 to be inserted in the ATM. . . ." Col. 6, ll. 42-43.

Because the processor unit 32 outputs different user interfaces to the user's display 20 and to the operator's display 28 in response to input signals from the user's card reader 14 and key pad 16 and from the operator's key pad 27, we find that Clark determines whether the input signals are from a user-type of input device, which has user capabilities, or from an operator-type of input device, which has operator capabilities, and then responsively displays a corresponding user interface. Therefore, we affirm the anticipation rejection of claim 1; of claim 8; and of claim 9, which falls with claim 8. We likewise affirm the obviousness rejection of claim 18; of claims 19 and 27, which fall with claim 18; and of claim 26.

**B. ANTICIPATION REJECTION OF CLAIMS 29 AND 30 AND
OBVIOUSNESS REJECTION OF CLAIMS 14, 20-23, 31-36, AND 39**

The examiner finds that in Clark "an authorized user (e.g. a customer) positioned adjacent to the panels can perform banking services such as depositing and/or withdrawing money to/from the ATM as shown in figure 1 while an authorized user (e.g., an operator) positioned adjacent to the operator panel can perform services such as periodic scheduled maintenance service, etc." (Examiner's Answer at 9.) The appellants argue, "a consumer's use of an ATM to withdraw cash in no way constitutes performing servicing operations with the ATM." (Reply Br. at 7.)

1. Claim Construction

Claim 29 recites in pertinent part the following limitations: "both the first user interface and the second user interface are adapted to enable an authorized user to perform servicing operations with the machine while positioned adjacent either the first user station or the second user station of the machine." Giving the claim the broadest, reasonable construction, the limitations require that a first user interface and a second user interface can be used to perform some servicing operations. The claim is not limited to specific operations, however; nor does the claim require that the operations enabled by the first user interface be the same as those enabled by the second user interface.

In contrast, claim 30 recites in pertinent part the following limitations: "the computer is operative to perform a **common** servicing operation responsive to selection of either the at least one first or the at least one second user interface elements." (Emphasis added.) Claims 14, 20, and 39 recite similar limitations. Giving claims 14, 20, 30, and 39 the broadest, reasonable construction, the limitations require that a first user interface and a second user interface can be used to perform the same servicing operation.

2. Anticipation and Obviousness Determinations

Clark discloses that the user interface displayed on the user's display 20 can be used to perform some servicing operations. Specifically, "a menu of the various facilities available to the user is . . . displayed on the screen 20. If a cash withdrawal facility is selected, the user is requested to enter the sum required on the key pad 16 or by means of additional keys 24 provided at the side of the screen 20." Col. 3, ll. 3-7. We agree with the examiner that withdrawing cash is a "banking service[]," (Examiner's Answer at 9), as is "depositing . . . money. . . ." (*Id.*)

The reference also discloses that the user interface displayed on the operator's display 28 can be used to perform some servicing operations. Specifically, "the operator is presented with a menu of the various maintenance procedure options, including a REPLENISH option, displayed on the display 28 of the operator panel 26."

Col. 5, ll. 61-64. We agree with the examiner that such options are "maintenance banking services. . . ." (Examiner's Answer at 9.)

Because claim 29 does not require that the operations enabled by the first user interface and those enabled by the second user interface be the same, we affirm the anticipation rejection of claim 29. Because claim 30 does require that the first user interface and the second user interface enable a common operation, in contrast, we reverse the anticipation rejection of claim 30.

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner does not allege, let alone show, that the addition of Coutts cures the aforementioned deficiency of Clark. Absent a teaching or suggestion of a first user interface and a second user interface can be used to perform the same

servicing operation, we are unpersuaded of a *prima facie* case of obviousness.

Therefore, we reverse the obviousness rejection of claim 14; of claim 20; of claims 21-23, which depend from claim 20; of claims 31-36, which depend from claim 30; and of claim 39.

C. OBVIOUSNESS REJECTION OF CLAIMS 2 AND 3

At the outset, the appellants recitation of the limitations of claim 3 and allegation that "Clark does not disclose or suggest," (Appeal Br. at 15), these limitations does not constitute an argument that the claim is separately patentable. It does not challenge the rejection of the individual claims with any reasonable specificity. Therefore, claim 3 stands or falls with representative claim 2.

The examiner asserts, "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Clark in order to provide an user friendly system for displaying a plurality of menu for supervisor mode related functions (e.g., status report, replenishing cash, etc.) on the first monitor along displaying message on the second displaying device, such as 'temporarily out of order,' etc. in which serves as a spanning of displaying devices." (Examiner's Answer at 4-5.) The appellants argue, "The ability of two displays in an ATM to output different information at the same time does not disclose or suggest a 'desktop environment' or a

desktop environment that spans 'first and second display devices'. . . ." (Reply Br. at 8.)

1. Claim Construction

Claim 2 recites in pertinent part the following limitations: "at least one computer is operative to cause a desktop environment to be generated, wherein the desktop environment spans the first and second display devices." The limitations define neither the "desktop environment" nor the "spanning." Giving the representative claim the broadest, reasonable construction, the limitations require showing related outputs on two displays.

2. Obviousness Determination

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (Bd.Pat.App & Int. May 2004). "The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Furthermore, a suggestion to combine teachings from the prior art "may be found in explicit or implicit teachings within . . . references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to

be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1335, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)). Although couched in terms of combining references, we hold that a suggestion to modify a reference may be drawn from the same range of sources.

Here, as aforementioned, Clark discloses a user's display 20 and an operator's display 28. Upon entering a Supervisor Mode, "the operator is presented with a menu of the various maintenance procedure options . . . displayed on the display 28 of the operator panel 26." Col. 5, ll. 61-64. While the operator is in the Supervisor Mode, "the ATM 10 is not available to customers for dispensing cash." *Id.* at ll. 56-57. When unavailable to a customer, those skilled in the art would have understood that the ATM could either notify him or not notify him of the temporary unavailability. Notifying the customer would have provided him with feedback that he could use to respond appropriately; not notifying the customer would have left him guessing as to the status of the ATM. Because the former situation would have been desirable to the latter, we find that a person of ordinary skill in the art would have been motivated to output a message on the user's display when the ATM was unavailable. Because that message would have been prompted by entry into the Supervisor Mode via the operator's panel 26, the message on the user's display would have been related to the

Supervisory Mode menu on the operator's display 28. Therefore, we affirm the obviousness rejection of claim 2 and of claim 3, which falls therewith.

D. OBVIOUSNESS REJECTION OF CLAIMS 4-7, 10, AND 11

The appellants advance the same argument for claims 4-7, which we address *infra*. Although they also recite the limitations of claims 5-7 and allege that neither Clark nor Coutts "discloses or suggests" these limitations, (Appeal Br. at 10-11), this does not constitute an argument that the claims are separately patentable. It does not challenge the rejection of the individual claims with any reasonable specificity. Therefore, claims 5-7 stand or fall with representative claim 4.

Similarly, although the appellants recite the limitations of claim 11 and allege that neither Clark nor Coutts "discloses or suggests" these limitations, (Appeal Br. at 19), this does not constitute an argument that the claim is separately patentable. It does not challenge the rejection of the individual claim with any reasonable specificity. Therefore, claim 11 stands or falls with representative claim 10.

The examiner finds, "a source file is needed to generate the executable file by compiling the source file and the commands are needed to generate the [graphical user interface] GUI. . . ." (Examiner's Answer at 6.) The appellants ask, "if the Office regards the JAVA program as a software application, then where does Coutts or Clark

disclose the separately recited element of a 'document' as recited in Appellants' claims 4-7?" (Reply Br. at 11.)

1. Claim Construction

Claim 4 recites in pertinent part the following limitations: "the at least one computer is operative to cause output of the first and second user interfaces responsive to the at least one first document." For its part, claim 5 explains that the document "includes a plurality of command instructions that correspond to hardware independent user interface elements." Claim 10 recites limitations similar to those of claims 4 and 5. Giving claims 4 and 10 the broadest, reasonable construction, the limitations require displaying a user interface responsive to a software application that determines a type of input device or a capability of the input device, respectively, and to computer instructions.

2. Obviousness Determination

For the reasons mentioned in considering the anticipation rejection of claims 1, 8, and 9 and the obviousness rejection of claims 18, 19, 26, and 27, we found that Clark displays a user interface responsive to a determination of whether an input device is of a first or second type and responsive to a determination of a capability of the input device. For its part, Coutts teaches that ATMs operate with software. "FIG. 4B illustrates a software architectural view," col. 5, ll. 4-5, of an ATM. More specifically,

the Figure shows a user interface application module 34, a card reader application module 23, a receipt printer application module 24, and a cash dispenser application module 25. A "[s]erver 16 may also contain the application software used by the modules in ATM 11." Col. 9, ll. 17-18.

"Each application module may run its own error handling, control and business logic based upon predetermined rules of operation." Col. 12, ll. 21-23. In summary, Coutts evidences that various software, which comprises computer instructions, is used to operate an ATM. We find that part of that software corresponds to the claimed "software application," while another part corresponds to the claimed "first document." Because the ATM displays a user interface responsive to a both parts, we affirm the obviousness rejection of claim 4; of claims 5-7, which fall with claim 4; of claim 10; and of claim 11, which falls with claim 10.

E. OBVIOUSNESS REJECTION OF CLAIMS 12 AND 13

The appellants group claims 12 and 13 under the heading, "**Claims 12 and 13.**" (Reply Br. at 12.) Although they also recite the limitations of claim 13 and allege that neither Clark nor Coutts "discloses or suggests" these limitations, (Appeal Br. at 19), this does not constitute an argument that the claim is separately patentable. It does not challenge the rejection of the individual claims with any reasonable specificity. Therefore, claim 13 stands or falls with representative claim 12.

The examiner finds, "the JAVA program of Coutts comprises a plurality of event processors such as ATMInterface, CardReader, CashDispenser invocable by the stored program of computer of the ATM machine for performing banking transaction using function devices such as card reader, etc." (Examiner's Answer at 16.) The appellants argue, "Claims 12 and 13 and their base claims, recite two separate elements of a 'document' and an 'event processor software component.' The Answer has only pointed to the single element, namely a JAVA Program, which is alleged to correspond to each of these elements." (Reply Br. at 12-13.)

1. Claim Construction

Claim 12 recites in pertinent part the following limitations: "at least one event processor software component in operative connection with the computer. . . ." Giving the representative claim the broadest, reasonable construction, the limitations require the aforementioned computer instructions and software for processing events.

2. Obviousness Determination

For the reasons mentioned in considering the obviousness rejection of claims 4-7, 10, and 11, we found that Clark and Coutts would have suggested computer instructions. Furthermore, the examiner's finding that Coutts' programs "comprise[] a plurality of event processors such as ATMInterface, CardReader, CashDispenser invocable by the stored program of computer of the ATM machine for performing

banking transaction using function devices such as card reader, etc," (Examiner's Answer at 16), is uncontested. For its part, Coutts validates the finding by teaching that "Application Section code for each of the three modules [viz., Card Reader, Receipt Printer, and Cash Dispenser] [is] separately packaged, and also came with an additional dialog class (ErrorDialog) that allowed a user to force the module to simulate 'hardware errors' that might occur in the real terminal, such as card jams, cash jams and running out of receipt paper. The packages can be seen in FIG. 42." Col. 46, ll. 62-67.

We find that any of the three modules is software for processing events, which is different than the aforementioned computer instructions. Therefore, we affirm the obviousness rejection of claim 12 and of claim 13, which falls therewith.

F. OBVIOUSNESS REJECTION OF CLAIMS 15-17

The examiner asserts, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to realize that the first document, the second document, the first command, the second command, the third command are used to generate the GUI system programmed with JAVA programming language, that is, a source file is needed to generate the executable file by compiling the source file and the commands are needed to generate the GUI interface that displays buttons, text fields, messages, etc. to receiving input from the user(s) and executing proper

functions with user input." (Examiner's Answer at 17-18.) The appellants argue, "Neither Clark nor Coutts discloses or suggests an automated banking machine that includes a first command instruction in a first document with a first label in a first human language, and a third command instruction in a second document with a second label in a second human language, that has a meaning corresponding to the first label." (Appeal Br. at 20.)

1. Claim Construction

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)). Here, claim 15 recites in pertinent part the following limitations: "the first document includes a first command instruction and a second command instruction; wherein [a] second document includes a third command instruction that corresponds to the first command instruction; wherein the first command instruction includes a first label in a first human language; wherein the third command instruction includes a second label in a second human language that has a meaning corresponding to the first label, and wherein the at least one software application is operative to output each user interface with indicia in the second human language responsive to both the first and second documents. . . ." Considering these limitations, the claim requires *inter alia* a first label in a first human language and

a second label in a second human language having a meaning corresponding to the first label.

2. Obviousness Determination

The examiner's rejection does not address the limitations of a first label in a first human language and a second label in a second human language that has a meaning corresponding to the first label. We will not "resort to speculation," *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), as to the examiner's position. Absent a teaching or suggestion of a first label in a first human language and a second label in a second human language having a meaning corresponding to the first label, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 15 and of claims 16-17, which depend therefrom.

G. OBVIOUSNESS REJECTION OF CLAIM 24 AND 25

The examiner asserts, "the JAVA program of Coutts is compiled with the main application including commands for importing the JAVA class files such as Account, CardReader, etc. and/or creating the objects or constructors wherein the imported JAVA class files, created objects, and constructors are including human readable language such as instructions and descriptions of each files and command to generate the graphical user interface (GUI) on the display of the ATM having a human readable language, for example, the display may display a message 'Insert card', 'Enter PIN,' etc.

wherein such displayed message is generated by the JAVA program stored in the automated banking machine and according to inputs of user lactated at the user panel and/or the operator panel." (Examiner's Answer at 23.) The appellants argue, "[N]either reference discloses or suggests at least one second document that includes at least one language translation of indicia included in the first document." (Appeal Br. at 25.)

1. Claim Construction

Claim 24 recites in pertinent part the following limitations: "the at least one second document includes at least one language translation of indicia included in the first document."

2. Obviousness Determination

The examiner's rejection does not address the limitations of "the at least one second document includes at least one language translation of indicia included in the first document." We will not resort to speculation as to the examiner's position. Nor does the examiner allege, let alone show, that Clark cures the aforementioned deficiency of Coutts. Therefore, we reverse the obviousness rejection of claim 24 and of claim 25, which depends therefrom.

H. OBVIOUSNESS REJECTION OF CLAIM 28 AND 40

The examiner asserts, "Coutts teaches the ATM machine is operated by using JAVA program wherein JAVA program serving as a markup language. . . ." (Examiner's Answer at 25.) The appellant argue, "Nowhere does Clark or Coutts disclose or suggest that a JAVA program corresponds to any type of markup language document. . . ." (Reply Br. at 21.)

1. Claim Construction

Claims 28 and 40 recite in pertinent part the following limitations: "a markup language document. . . ."

2. Obviousness Determination

The examiner's rejection does not explain how Coutts' JAVA program "serv[es] as a markup language. . . ." (Examiner's Answer at 25.) We will not resort to speculation as to the examiner's position. Nor does the examiner allege, let alone show, that Clark cures the aforementioned deficiency of Coutts. Therefore, we reverse the obviousness rejection of claims 28 and 40.

I. OBVIOUSNESS REJECTION OF CLAIM 37

The examiner finds, "Clark teaches . . . data/information related with the first input device (e.g., the card reader located in the user panel) will be displayed on the

first display device (20) located in the user panel where as data/information related with the second input device (e.g., the keypad located in the operator panel) will be displayed on the second display device (28) located on the operator panel."

(Examiner's Answer at 29-30.) The appellants make the following allegations.

[N]owhere does Clark or Coutts disclose or suggest a software application of an automated banking machine which is operative to cause a computer of the machine to determine a first input device type and a second input device type associated respectively with at least one first input device and at least one second input device of the machine. Nowhere does Clark or Coutts disclose or suggest that the software application is operative to include in the first user interface responsive to at least one command instruction in a document and the first input device type, at least one first user interface element adapted to be selected through the at least one first input device. Further, nowhere does Clark or Coutts disclose or suggest a software application that includes in the second user interface responsive to the at least one command instruction and the second input device type, at least one second user interface element adapted to be selected through the at least one second input device.

(Reply Br. at 26.)

"For each rejection under 35 U.S.C. [§] 103, the [appellants'] argument shall specify the errors in the rejection. . . ." 37 C.F.R. § 1.192 (c)(8)(iv). Here, although the examiner has specifically addressed claim 37, (Examiner's Answer at 29-30), the appellants have not addressed, let alone shown error in his specific findings.

Therefore, we affirm the obviousness rejection of claim 37.

J. OBVIOUSNESS REJECTION OF CLAIM 38

The examiner finds, "Clark teaches a keypad as an input device and the ATM machine of Coutts also comprises a touch screen for emulating pointing device such as mouse device for selecting of menu provided on the display device." (Examiner's Answer at 31.) Admitting that "the asserted teaching of a touch screen in Coutts may correspond to a pointing device," (Reply Br. at 26), the appellants argue, "the presence of a touch screen in Coutts does not provide a teaching, suggestion or motivation to modify Clark to include at least one first input device of a first user station that comprises a keypad, and at least one second input device of a second user station that comprises a pointing device. . . ." (*Id.*)

1. Claim Construction

Claim 38 recites in pertinent part the following limitations: "the at least one first input device comprises a key pad, wherein the at least one second input device comprises a pointing device. . . ." Giving the representative claim the broadest, reasonable construction, the limitations require a key pad for a first station and a pointing device for a second station.

2. Obviousness Determination

As explained regarding the anticipation rejection of claims 1, 8, and 9 and obviousness rejection of claims 18, 19, 26, and 27, Clark's user panel 12 and operator

panel 26 feature key pads 16 and 27, respectively. The appellants admit, moreover, that the "touch screen in Coutts may correspond to a pointing device. . . ." (Reply Br. at 26.)


We are persuaded that those skilled in the art would have been aware of the advantages inherent to a touch screen such as allowing a user to interact more directly and intuitively with a graphical user interface rather than typing keys on a key pad. We find that such an advantage would have persuaded one skilled in the art to add a touch screen to the user panel or operator panel of Clark. Therefore, we affirm the obviousness rejection of claim 38.

III. CONCLUSION

In summary, the rejection of claims 1, 8, 9, and 29 under § 102(e) is affirmed, while the rejection of claim 30 under § 102(e) is reversed. The rejections of claims 2-7, 10-13, 18, 19, 26, 27, 37, and 38 under § 103(a) are affirmed, while the rejection of claims 14-17, 20-25, 28, 31-36, 39, and 40 under § 103(a) is reversed.


KENNETH W. HAIRSTON
Administrative Patent Judge

Administrative Patent Judge



LANCE LEONARD BARRY
Administrative Patent Judge

BOARD OF APPEALS
APPEALS


ROBERT E. NAPPI
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2005-2622
Application No. 09/923,089

Page 31

RALPH E. JOCKE
WALKER & JOCKE, L.P.A.
231 SOUTH BROADWAY
MEDINA, OH 44256